No. 18-302

IN THE

Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

ERIK BRUNETTI,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF THE RUTHERFORD INSTITUTE AS *AMICUS CURIAE* IN SUPPORT OF RESPONDENT

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INTEREST OF *AMICUS CURIAE*[1]

The Rutherford Institute is an international civil liberties organization headquartered in Charlottesville, Virginia. Founded in 1982 by its President, John W. Whitehead, the Institute specializes in providing legal representation without charge to individuals whose civil liberties are threatened and in educating the public about constitutional and human rights issues. Attorneys affiliated with the Institute have represented parties and filed numerous *amicus curiae* briefs in the federal Courts of Appeals and Supreme Court. The Rutherford Institute works to preserve the most basic freedoms of our Republic, including the limits placed on government by the First Amendment. The Rutherford Institute opposes governmental action to burden or censor speech for the purpose of protecting the subjective sensibilities of part of the audience.

The Rutherford Institute has helped develop key First Amendment principles informing the reach of government power. *See, e.g.*, *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 570 U.S. 205 (2013); *Sorrell v. IMS Health Inc.*, 564 U.S. 552 (2011); *Snyder v. Phelps*, 562 U.S. 443 (2011); *Rust v. Sullivan*, 500 U.S. 173 (1991). The Rutherford Institute also participated as *amicus curiae* in *Matal v. Tam*, 137 S. Ct. 1744 (2017), in which the government similarly claimed the power to

1. Pursuant to Rule 37.3(a), Petitioner and Respondent have provided written consent to the filing of this brief. Pursuant to Rule 37.6, *amicus* affirms that no counsel for a party authored this brief in whole or in part and that no person other than *amicus* and its counsel made a monetary contribution to the preparation or submission of this brief.

judge speech based on viewpoint and content, free from First Amendment scrutiny.

SUMMARY OF ARGUMENT

The government uses the Lanham Act's scandalous-marks provision to suppress speech that may offend members of the public. As Justice Alito's plurality opinion in *Tam* recognized, "that is viewpoint discrimination: Giving offense is a viewpoint." *Tam*, 137 S. Ct. at 1763 (Alito, J.); *see also id.* at 1766 (Kennedy, J., concurring) ("The law thus reflects the Government's disapproval of a subset of messages it finds offensive. This is the essence of viewpoint discrimination."). The government does not deny that it refuses to register trademarks based on whether the government believes the trademark would cause offense. Instead, the government claims that its discretionary refusal to register offensive marks is viewpoint neutral and does not restrict speech at all because it is merely a condition on the availability of a government benefit.

This is nonsense. Trademarks are protected speech. A trademarked name, word, phrase, logo, or design can do far more than identify the source of a product or service. Trademarks—including scandalous trademarks—"often have an expressive content." *Tam*, 137 S. Ct. at 1760 (Alito, J.). Although the speech expressed in trademarks is brief, "powerful messages can sometimes be conveyed in just a few words." *Id.*

For example, SCREW CANCER (Reg. No. 4011638), SCREW YOU, CANCER! (Reg. No. 4685551), CAPITALISM SUCKS DONKEY BALLS (Reg. Nos.

4978662, 4744351), and CAPITALISM SCREWED MY MOTHER (Reg. No. 4629158) are all registered trademarks. At the same time, FUCK CANCER (Ser. Nos. 86/290011, 86/288375, 86/924028), FUCK RACISM (Ser. Nos. 87/303302, 85/608559), FUCK SENSITIVITY (Ser. No. 85/761742), F*CK YOU! WOMEN LIFT TOO! (Ser. No. 87/445911) and DON'T FUCK WITH THE JEWS (Ser. No. 78/822587) were all denied registration as scandalous, or the applicant was given notice that the mark "normally would be refused registration" as scandalous but that action was suspended pending the outcome of this case.

These examples belie the government's attempt to separate a mark's emotive element from the ideas a mark communicates. Pet. Br. 27-28. As this Court recognized in *Cohen v. California*, 403 U.S. 15 (1971), it is a "facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process"— an assumption that may lead to "censorship of particular words as a convenient guise for banning the expression of unpopular views." *Id.* at 26.

The government's refusal to register the trademark at issue here demonstrates the use of the scandalous-marks provision to punish disfavored ideas. The PTO denied registration because it considered "FUCT" to be an "extremely offensive" term that in the context of Respondent's website and products expresses "extreme misogyny, nihilism, or violence." Pet. App. 65a.

Brunetti challenged the PTO's rejection of his mark, and after this Court's decision in *Tam*, the Federal Circuit held that the scandalous-marks provision of Section 1052(a)

is facially invalid under the First Amendment. The appeals court properly determined that the scandalous-marks provision is subject to strict scrutiny because it "targets the expressive components of the speech," and therefore discriminates based on content. Pet. App. 30a.[2] Notably, the court explained that "[a]s in this case, the [PTO] often justifies its rejection of marks on the grounds that they convey offensive ideas," and thus makes "value judgments about the expressive message behind the trademark." *Id.*

Even in the wake of this Court's decision in *Tam*, the United States has again chosen to defend the Lanham Act by embracing its role as the arbiter of taste, making the high-minded claim that the government has a legitimate interest in "avoiding any appearance of government approval of" scandalous marks. Pet. Br. 13. The United States' position undermines the core role of the First Amendment as a check on government power, which the Court has vigorously upheld.

Trademark registration cannot be used to burden speech in an effort to shield the public from offense. This is anathema to the First Amendment. "A law that can be directed against speech found offensive to some portion of the public can be turned against minority and dissenting views to the detriment of all. The First Amendment does not entrust that power to the government's benevolence." *Tam*, 137 S. Ct. at 1769 (Kennedy, J., concurring). In light of its decision in *Tam*, this Court should extricate the government from policing offense and confirm that the power of government is not properly deployed by using a

2. The Federal Circuit assumed without deciding that the scandalous-marks provision is viewpoint neutral. Pet. App. 14a.

century-old statute permitting discretionary trademark registration to pick winners and losers on the playing field of expression. The market, and consumers, benefit from vibrant expression free from government interference. This Court should affirm the appeals court decision and continue its longstanding commitment to vindicating the First Amendment, even when it protects unpleasant speakers and speech.

ARGUMENT

I. THE SCANDALOUS-MARKS PROVISION IMPERMISSIBLY RESTRICTS SPEECH THAT GOVERNMENT OFFICIALS DISLIKE BECAUSE IT MAY CAUSE OFFENSE.

A. The Scandalous-Marks Provision Is A Restriction On Speech, Not A Condition On The Availability Of A Government Benefit.

"Federal registration" of trademarks "'confers important legal rights and benefits on trademark owners who register their marks,'" the denial of which places applicants at a legal and financial disadvantage. *Tam*, 137 S. Ct. at 1753 (quoting *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1317 (2015)). As a result, the government finds itself squarely in the heartland of cases holding that the First Amendment imposes limits on government action, even where the action at issue is the denial of a benefit to which the recipient otherwise "has no entitlement." *Agency for Int'l Dev.*, 570 U.S. at 214 (citations omitted); *accord Rumsfeld v. Forum for Acad. & Inst. Rights, Inc.*, 547 U.S. 47, 59 (2006) ("'[T]he government may not deny a benefit to a person on a basis

that infringes his constitutionally protected . . . freedom of speech even if he has no entitlement to that benefit.'") (citations omitted).

To avoid this, Petitioner argues that the PTO's discretionary review for scandalousness is simply a "condition on the availability of a government benefit," not a restriction on speech. Pet. Br. 20. This argument hinges on the Petitioner's distinction between "us[ing] content-based criteria . . . to determine whether particular private speech should be *prohibited*," and using such criteria "to allocate various government benefits." *Id.* at 22 (emphasis in original). Petitioner claims that the scandalous-marks provision falls within the latter rather than the former, attempting to analogize the scandalous-marks provision to cases that afford the government leeway to make content-based distinctions when the government subsidizes speech. This attempt fails.

As Justice Alito's plurality opinion in *Tam* recognized, "the decisions on which the government relies all involved cash subsidies or their equivalent" (i.e. "tax benefits"), and "[t]he federal registration of a trademark is nothing like the programs at issue in these cases." *Tam*, 137 S. Ct. at 1761 (Alito, J.). Petitioner's theory thus represents an attempt to greatly expand the government-subsidy cases, which would exempt vast and varied government activity from First Amendment scrutiny.

First, although trademark registration confers benefits, federal funds are not one of them. "The PTO does not pay money to parties seeking registration of a mark. Quite the contrary is true: An applicant for registration must pay the PTO a filing fee of $225-$600[,] . . . [a]nd to

maintain federal registration, the holder of a mark must pay a fee of $300-$500 every 10 years." 137 S. Ct. at 1761 (Alito, J.).

Second, the benefits of federal trademark registration simply are not analogous to Congress's grant of federal funds or provision of tax benefits to subsidize speech. Congress did not establish trademark registration to further any message or viewpoint. *Tam*, 137 S. Ct. at 1768 (Kennedy, J., concurring) (noting that "[t]here may be situations where private speakers are selected for a government program to assist the government in advancing a particular message," but trademark registration is not one of them); *Cf. Rust*, 500 U.S. at 192 (permitting a government family-planning program to limit abortion-related speech); *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569 (1998) (permitting the National Endowment for the Arts to subsidize certain artistic expression over others).

Petitioner's reliance on *Davenport v. Washington Education Association*, 551 U.S. 177 (2007), and *Ysursa v. Pocatello Education Association*, 555 U.S. 353 (2009), is particularly misplaced. Justice Alito's plurality opinion in *Tam* makes clear that these "two cases involving a public employer's collection of union dues from its employees . . . occupy a special area of First Amendment case law, and they are far removed from the registration of trademarks." 137 S. Ct. at 1761-62 (Alito, J.). Although Petitioner acknowledges that "Justice Alito's opinion in *Tam* rejected the government's reliance on *Davenport* and *Ysursa*," Petitioner tries to cabin that rejection by claiming that it took place "in the context of a viewpoint discriminatory provision." Pet. Br. 43. However, Justice Alito's rejection

of the government's reliance on *Davenport* and *Ysursa* was not premised on the disparagement provision's viewpoint discrimination. Instead, Justice Alito's opinion appropriately limited the reach of *Davenport* and *Ysursa* to "a special area of First Amendment case law" not at issue here. *Tam*, 137 S. Ct. at 1762 (Alito, J.).

Even if Section 1052(a) were a subsidy program, the First Amendment limits the government's power to use subsidy programs to discriminate against certain viewpoints. *Tam*, 137 S. Ct. at 1768-69 (Kennedy, J., concurring); *see also Regan v. Taxation With Representation of Washington*, 461 U.S. 540, 550 (1983) (internal quotation marks and citation omitted) (stating that the government may not aim subsidies "at the suppression of dangerous ideas"); *Leathers v. Medlock*, 499 U.S. 439, 447 (1991) ("[D]ifferential taxation of First Amendment speakers is constitutionally suspect when it threatens to suppress the expression of particular ideas or viewpoints"). Imposing burdens on speakers based on the content of their speech "may effectively drive certain ideas or viewpoints from the marketplace." *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 116 (1991). That is what the government tries to accomplish through the scandalous-marks provision. The government cannot have it both ways. Even if it could treat trademarks as a federal subsidy—which it cannot—it must abide the limitations on that power.

B. The Scandalous-Marks Provision, Like The Disparagement Provision Invalidated By *Tam*, Discriminates Based On Viewpoint And Content.

After this Court's decision in *Tam*, the scandalous-marks provision cannot be construed as viewpoint neutral. This Court's "cases use the term 'viewpoint' discrimination in a broad sense." *Tam*, 137 S. Ct. at 1763 (Alito, J.). Thus, as Justice Alito's plurality opinion concluded, even though the disparagement provision "evenhandedly prohibit[ed] disparagement of all groups[,] . . . that is viewpoint discrimination: *Giving offense is a viewpoint.*" *Id.* (emphasis added); *see also id.* at 1766-67 (Kennedy, J., concurring). The same is true of the scandalous-marks provision. It evenhandedly prohibits offending any substantial portion of the general public. As Justice Alito noted in *Tam*, "we have said time and again that 'the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers.'" *Id.* at 1763 (Alito, J.) (quoting *Street v. New York*, 394 U.S. 576, 592 (1969), and collecting cases); *see also id.* at 1766-67 (Kennedy, J., concurring) ("The Government may not insulate a law from charges of viewpoint discrimination by tying censorship to the reaction of the speaker's audience. . . . The danger of viewpoint discrimination is that the government is attempting to remove certain ideas or perspectives from a broader debate. That danger is all the greater if the ideas or perspectives are ones a particular audience might think offensive, at least at first hearing.").

And contrary to the government's claims, the scandalous-marks provision does not simply restrict

"especially offensive *mode[s]* of expression." Pet. Br. 28 (emphasis added); *see also id.* at 12, 20, 27-28. It suppresses the underlying *ideas* expressed by the trademark and thus strikes at the heart of the First Amendment. As discussed further below, this Court has long recognized that under the First Amendment, the emotive element of speech cannot be separated from the ideas being communicated. *Cohen*, 403 U.S. at 26.

Notably, the Federal Circuit found that "[a]s in this case, the [PTO] often justifies its rejection of marks on the grounds that they convey offensive ideas." Pet. App. 30a. In rejecting Respondent's mark as scandalous, the PTO's Trademark Trial and Appeal Board emphasized that Respondent uses his mark "in the context of extreme misogyny, nihilism or violence." *Id.* at 65a.[3]

The Federal Circuit correctly observed that "[t]hese are each value judgments about the expressive message behind the trademark. Whether marks comprise . . . scandalous subject matter hinges on the expressive, not source-identifying, nature of trademarks." Pet. App. 30a. Indeed, nihilism is a philosophical viewpoint. Thus, even though individuals may justly be offended by the content associated with the mark at issue here, the speaker clearly has a viewpoint he is expressing.

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3. According to the Board, Respondent's mark appears on clothing and on his website with "strong, and often explicit, sexual imagery that objectifies women and offers degrading examples of extreme misogyny" as well as imagery "of extreme nihilism – displaying an unending succession of anti-social imagery of executions, despair, violent and bloody scenes including dismemberment, hellacious or apocalyptic events, and dozens of examples of other imagery lacking in taste." Pet. App. 63a-64a.

1. This Case Is More Like *Cohen* Than The Government Will Admit.

This Court has already held that a jacket bearing the words "Fuck the Draft" is protected by the First Amendment because of the message it conveys. *Cohen*, 403 U.S. 15. The result should be no different for Brunetti's attempt to register "FUCT" as a trademark for clothing and other goods.

While the settings are different, the government's attempt to distinguish *Cohen* is unpersuasive. Pet. Br. 29. Contrary to the government's brief, the Court found that Cohen's conviction "quite clearly rest[ed] upon the asserted offensiveness of the words Cohen used to convey his message to the public," which implicated the First Amendment's ban on viewpoint discrimination. 403 U.S. at 18. The Court described the position the government attempts to advance here as a "facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process"—an assumption that may lead to "censorship of particular words as a convenient guise for banning the expression of unpopular views." *Id.* at 26. The Court correctly refused to condone "running the risk of opening the door to such grave results." *Id.*

The Lanham Act's ban on scandalous marks presents a similar risk and should be given the same reception by this Court. Indeed, the records of the PTO are replete with refusals to register expressive marks as scandalous, or notice to the trademark applicants that the marks "normally would be refused registration" as scandalous

but that action was suspended pending the outcome of this case:

- CORPORATE MASTURBATION (Ser. No. 77/747036)
- PUSSY POWER (Ser. Nos. 88/163730, 87520058)
- F*CK YOU! WOMEN LIFT TOO! (Ser. No. 87/445911)
- I DON'T GIVE A F K WHO YOU LOVE (Serial No. 85/404175)[4]
- FUCK SENSITIVITY (Ser. No. 85/761742)
- FUCK RACISM (Ser. Nos. 87/303302, 85/608559)
- FUCK FEAR (Ser. No. 87/628707)
- FUCK FEAR. MAKE LOVE. (Ser. No. 88/004995)

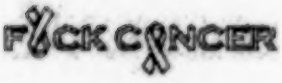
4.

- FUCK CANCER (Ser. Nos. 86/290011, 86/288375, 86/924028)[5]

- FUK WHAT SOCIETY SAY (Ser. No. 87/787921)

The government also attempts to downplay the significance of *Cohen* by arguing that "the Court distinguished that 'emotive' element" of Cohen's speech "from the substance of the 'ideas' themselves." Pet. Br. 29. But the Court considered the "emotive function" of speech to be part of the viewpoint it expressed, emphasizing that the emotive function "may often be the more important element of the overall message sought to be communicated." *Cohen*, 403 U.S. at 25-26 ("[M]uch linguistic expression serves a dual communicative function: it conveys not only ideas capable of relatively precise, detached explication, but otherwise inexpressible emotions as well.").

5.



The Court thus rejected the view—implicitly advanced by the government—that "the Constitution, while solicitous of the cognitive content of individual speech, has little or no regard for that emotive function which practically speaking, may often be the more important element of the overall message sought to be communicated." *Id.* at 26.

Thus, even if the PTO were interested only in banning profanity, its attempt to police crude language surely suppresses important messages. For example, the PTO has repeatedly refused to register FUCK CANCER (Ser. Nos. 86/290011, 86/288375, 86/924028), but has allowed SCREW CANCER (Reg. No. 4011638), SCREW YOU, CANCER! (Reg. No. 4685551), and SUCK IT, CANCER (Reg. No. 4999260)—the value judgment apparently being that it is acceptable to oppose cancer, just not too strongly.

2. The Rationale of *Pacifica* Does Not Justify The Scandalous-Marks Provision.

The government also cites *FCC v. Pacifica Foundation*, 438 U.S. 726 (1978), for the proposition that the regulation of profanity is viewpoint neutral. Pet Br. 28. But that case is inapposite as the Court was at pains to "emphasize the narrowness of [its] holding." 438 U.S. at 748–50. *Pacifica* concerned a radio broadcast, which "of all forms of communication . . . has received the most limited First Amendment protection" because "indecent material presented over the airwaves confronts the citizen, not only in public, but also in the privacy of the home" and is "uniquely accessible to children." *Id.*; *City of Los Angeles v. Preferred Commc'ns, Inc.*, 476 U.S. 488, 496 (1986)

("Different communications media are treated differently for First Amendment purposes.").[6]

As the Federal Circuit correctly observed, "[t]he government's interest in protecting the public from profane and scandalous marks is not akin to the government's interest in protecting children and other unsuspecting listeners from a barrage of swear words over the radio in *Pacifica*." Pet. App. 37a. As the government well knows, "a trademark is not foisted upon listeners by virtue of its being registered," "[n]or does registration make a scandalous mark more accessible to children." *Id.* at 37a-38a.

3. The Scandalous-Marks Provision—Unlike The Other Provisions Of Section 1052(a)-(e)—Targets A Mark's Expressive Message.

The government concedes that the scandalous-marks provision discriminates based on content. Pet. Br. 14 ("In determining whether particular marks are eligible for registration, the USPTO necessarily must consider the content of the marks. Section 1052(a)'s scandalous-marks provision is simply one of many content-based registration bans . . . ."). The government argues, however, that the same is true of many of the other provisions of Section

6. Similarly, this Court's decision in *Bethel School District No. 403 v. Fraser*, 478 U.S. 675 (1986), turned on the unique "[r]ole and purpose of the American public school system" and the fact that the offensive speech at issue was delivered at a school assembly to children, "many of whom were 14-year-olds." *Id.* at 677-81 (citing *Tinker v. Des Moines Indep. Sch. Dist.*, 393 U.S. 503 (1969)).

1052(a)-(e), and that to subject them all to strict scrutiny "would fundamentally disrupt the operation of the federal registration program." *Id.* at 26.

This argument fails to distinguish between the many provisions of Section 1052(a)-(e) that target a mark's source-identifying information, and the scandalous-marks provision, which targets a mark's expressive message. Examples of provisions of Section 1052(a)-(e) that target a mark's source-identifying information include provisions requiring that marks not be deceptive, 15 U.S.C. § 1052(a); not contain a flag, coat of arms, or insignia of the United States, a State, or a foreign nation, *id.* § 1052(b); not include a name, portrait, or signature of a living person without his or her consent, *id.* § 1052(c); not so resemble other marks as to create a likelihood of confusion, *id.* § 1052(d); not be merely descriptive, *id.* § 1052(e)(1); and not be functional, *id.* § 1052(e)(5).

These provisions all relate to "[t]he central purpose of trademark registration," which is "to facilitate source identification." *Tam*, 137 S. Ct. at 1768 (Kennedy, J., concurring). The scandalous-marks provision, by contrast, bears no plausible relation to that central purpose. Instead, it targets a mark's expressive message, which is separate and distinct from the commercial purpose of a mark as a source identifier. Given this distinction, subjecting the scandalous-marks provision to strict scrutiny would not require subjecting the other provisions of Section 1052(a)-(e) to strict scrutiny.[7]

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7. Although these provisions are not before the Court, it is entirely possible that they would survive heightened scrutiny even if they were subject to it.

C. The Lanham Act Gives Government Officials Near-Unfettered Discretion To Bar Registration Of Marks They Deem Scandalous, Yielding Incoherent Decisions.

The government asserts that the PTO "relies on an objective standard to determine whether registration of a particular mark is prohibited by the scandalous-marks provision." Cert. Reply 4-5. As this Court noted in *Tam*, however, the PTO has acknowledged the opposite: "the guidelines 'for determining whether a mark is scandalous or disparaging are somewhat vague and the determination of whether a mark is scandalous or disparaging is necessarily a highly subjective one.'" *Tam*, 137 S. Ct. at 1756 n.5 (quoting *In re In Over Our Heads, Inc.*, 16 USPQ 2d 1653, 1654 (TTAB 1990) (brackets and internal quotation marks omitted)). The admitted vagueness of the scandalous-marks test, like the "admitted vagueness of the disparagement test," coupled with "the huge volume of applications"—"more than 400,000 trademark applications each year," Pet. Br. 46—"have produced a haphazard record of enforcement." *Tam*, 137 S. Ct. at 1757.

Under Section 1052(a) and the PTO's implementing regulations, the PTO polices trademark registration applications for scandalous marks, which are "absolute[ly]" prohibited. Trademark Manual of Examining Procedure ("TMEP") § 1203.01 (Oct. 2018), http://tmep.uspto.gov. The PTO defines the term "scandalous" to mean "*inter alia*, shocking to the sense of propriety, offensive to the conscience or moral feelings or calling out for condemnation," or "'vulgar,' defined as 'lacking in taste, indelicate, morally crude.'" *Id.* (quoting *In re Runsdorf*, 171 USPQ 443, 444 (TTAB 1971)).

Using this vague definition, a PTO examiner is supposed to evaluate whether a mark is scandalous from the "standpoint" of a "substantial portion"—but "not necessarily a majority"— "of the general public." TMEP §1203.01. In engaging in this hypothetical, highly subjective exercise, the examiner is supposed to consider the mark "in the context of contemporary attitudes" and "the relevant marketplace for the goods or services identified in the application." *Id.* The examiner, at his or her discretion, may rely on dictionary definitions alone, may consider "newspaper articles" and "magazine articles," and "may look to the specimen(s) or other aspects of the record." *Id.* In short, the examiner is invited to pick and choose sources and to dabble in the social sciences to come to some conclusion as to whether the mark meets this vague standard.[8]

This lawless process does not comport with the strict requirements of the First Amendment. Not surprisingly, with flexible and shifting considerations, review yields unpredictable results, linked by a common theme: subjective and paternalistic review of the potential

8. Even if the mark is meant to convey humor or a double entendre—clearly expressive speech—the TMEP instructs the examiner to focus solely on the offensive aspect of the mark. *See* TMEP § 1203.01 ("Whether applicant intended the mark to be humorous, or even whether some people would actually find it to be humorous, is immaterial.") (citing *In re Fox*, 702 F.3d 633, 634 (Fed. Cir. 2012) ("a mark that creates a double entendre falls within the proscription of §1052(a) where, as here, one of its meanings is clearly vulgar"); *In re Star Belly Stitcher, Inc.*, 107 USPQ 2d 2059, 2063 (TTAB 2013) ("[T]here is no requirement in Section 2(a) that a mark's vulgar meaning must be the only relevant meaning, or even the most relevant meaning.").

to cause offense to some members of the public. Such review is hard to square with our system of content- and viewpoint-neutral government. *Tam*, 137 S. Ct. at 1765 ("it is a fundamental principle of the First Amendment that the government may not punish or suppress speech based on disapproval of the ideas or perspectives the speech conveys") (Kennedy, J., concurring).

The lack of administrable standards ensures that trademarks are "contingent upon the uncontrolled will of an official," which this Court has made clear is "an unconstitutional censorship." *Shuttlesworth v. City of Birmingham, Ala.*, 394 U.S. 147, 151 (1969). *See, e.g., Saia v. New York*, 334 U.S. 558, 559-60 (1948) (striking down a New York loud-speaker permitting scheme where the police chief had unbounded discretion to grant or deny permits); *City of Lakewood v. Plain Dealer Publ'g Co.*, 486 U.S. 750, 764 (1988) ("[The government] may not condition that speech on obtaining a license or permit from a government official in that official's boundless discretion."). Here, these discretionary decisions are particularly troubling since they are "based upon the content of the speech or viewpoint of the speaker." *City of Lakewood*, 486 U.S. at 763-64.

Unsurprisingly, the PTO's record reveals a bevy of content and viewpoint-based judgments that change over time and border on incoherence. For example, while FUCT was refused registration, FCUK was granted registration (Reg. Nos. 3028227, 2520614, and 2920270), as were all of the following arguably vulgar marks: FAUQ-YEAH! (Reg. No. 5282969); MUTHA EFFIN BINGO (Reg. No. 4183272); F'D UP (Reg. No. 4495813); WTF WHERE'S THE FOODTRUCK (Reg. No. 5642124);

WTFHAPPENED.COM (Reg. No. 4389264); and WTF WORK? (Reg. No. 4332574).[9]

The government attempts to downplay the incoherence in these decisions as mere "alleged inconsistencies." Pet. Br. 14, 47. But the issue is not simply a few "allegedly erroneous registration[s]" *id.* at 46, but rather the conscious use of trademark registration to censor some viewpoints under the guise of protecting people from offensive speech. As this Court explained in *Cohen*, "governmental officials cannot make principled distinctions in . . . matters of taste and style." *Cohen*, 403 U.S. at 25.

Inconsistencies serve to highlight the lack of a limiting principle in applying the scandalous-marks provision, making the process ripe for arbitrary application. *Heffron v. Int'l Soc'y for Krishna Consciousness, Inc.*, 452 U.S. 640, 649 (1981) (stating the Court condemns arbitrary discretion because "such discretion has the potential for becoming a means of suppressing a particular point of view"). Such discriminatory treatment of viewpoints is an "'egregious form of content discrimination,' which is 'presumptively unconstitutional.'" *Tam*, 137 S. Ct. at 1766 (Kennedy, J., concurring) (quoting *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U. S. 819, 829–830 (1995));

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9. For empirical analyses of the PTO's application of the scandalous-marks provision, *see, e.g.*, Emily Kustina, *Discriminatory Discretion: PTO Procedures and Viewpoint Discrimination Under Section 2(a) of the Lanham Act*, 164 U. Pa. L. Rev. 513 (2016); Megan Carpenter & Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 Cardozo Arts & Ent. L.J. 321 (2015); Anne LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 Trademark Rep. 1476 (2011).

see also Reed v. Town of Gilbert, Ariz., 135 S. Ct. 2218, 2230 (2015).

II. THE SCANDALOUS-MARKS PROVISION FAILS STRICT AND INTERMEDIATE SCRUTINY.

The government zigzags through several doctrines, disclaiming any viewpoint discrimination, Pet. Br. 26-30, conceding content discrimination but denying the applicability of strict scrutiny, Pet. Br. 25-26, faintly invoking *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557 (1980), Pet. Br. 36-38, and ultimately arguing that the scandalous-marks provision is not a restriction on speech at all but merely a condition on the availability of a government benefit, to which highly deferential rational basis review applies. Pet. Br. 22-24, 31-40. This is all wrong.

A. Strict Scrutiny Dooms the Scandalous-Marks Provision.

Petitioner does not even attempt to argue that the scandalous-marks provision survives strict scrutiny, and with good reason. It does not. Section 1052(a)'s scandalous-marks provision is subject to the most stringent judicial review. Laws allowing the government to discriminate among speakers based on viewpoint or content are unacceptable absent narrow tailoring to serve a compelling government interest. *E.g., R.A.V. v. City of St. Paul*, 505 U.S. 377, 395 (1992).

Here, the government asserts interests in (1) "encouraging the use of marks that are appropriate for all audiences, including children," (2) "the orderly

flow of commerce," and (3) "avoiding any appearance of government approval of" scandalous marks. Pet. Br. 13. Even if these interests were compelling—and only the second one arguably is—the government makes no showing of how the scandalous-marks provision is narrowly tailored to serve these interests, nor could it.[10] The scandalous-marks provision thus fails strict scrutiny.

B. The Scandalous-Marks Provision Fails Intermediate Scrutiny Because It Is Not Narrowly Tailored To And Does Not Directly And Materially Advance A Substantial Government Interest.

The government seeks to take advantage of this Court's commercial speech jurisprudence, invoking *Central Hudson*, but in the service of the government's preferred rational basis standard of review. Pet. Br. 36-38. Petitioner does not attempt to argue that the scandalous-marks provision could withstand even intermediate scrutiny. It cannot.

Under *Central Hudson*, a restriction of speech must be narrowly tailored to serve a substantial government interest and must directly and materially advance that interest. *Central Hudson*, 447 U.S. at 566; *see also Edenfield v. Fane*, 507 U.S. 761, 767 (1993) (explaining

10. The government's interest in the orderly flow of commerce is arguably compelling, but it strains credulity to claim, as the government does, that scandalous marks are "disruptive" to the flow of commerce "by making commercial transactions less efficient." Pet. Br. 34. As the Federal Circuit noted, "the government has failed to articulate how this interest is in any way advanced by the [scandalous-marks provision]." Pet. App. 32a n.4.

that under *Central Hudson*, the Court "must ask whether . . . the challenged regulation advances [the government's] interests in a direct and material way"); *Bd. of Tr. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 479-80 (1989) (explaining that *Central Hudson* requires "not necessarily the least restrictive means but . . . a means narrowly tailored to achieve the desired objective"). It is the government's burden to justify its regulation of commercial speech as consistent with the First Amendment. *Sorrell*, 564 U.S. at 565.

The scandalous-marks provision is not narrowly tailored to serve—and does not directly and materially advance—any substantial government interest. The first asserted interest, which seeks to prevent offense, is inconsistent with the First Amendment to such a degree that the Supreme Court has "found it so 'obvious' as to not require explanation." *Simon & Schuster*, 502 U.S. at 115-16 (citation omitted). In any event, the government's reliance on the fact that Respondent remains free to use the mark without federal registration demonstrates that the scandalous-marks provision does not directly or materially serve the asserted interest. *See* Pet. Br. 23 ("the owner may continue using its mark—and any other vulgar term or image it wishes—to identify its goods in commerce").

Although the second asserted interest in the orderly flow of commerce is substantial, the government has failed to show how this interest is in any way advanced by the scandalous-marks provision. As already noted, it strains credulity to claim, as the government does, that scandalous marks are "disruptive" to the flow of commerce "by making commercial transactions less efficient." Pet.

Br. 34; *see Tam*, 137 S. Ct. at 1764-65 (Alito, J.) (rejecting a similar argument that the disparagement provision disrupts the flow of commerce). In any event, as the government concedes, refusing to register scandalous marks does not prevent their use in commerce. Pet. Br. 23.

The third asserted interest—avoiding any appearance of government approval of scandalous marks—is not served by the scandalous-marks provision, even assuming that the interest is substantial. *See* Pet. Br. 34-36. As the Court found in *Tam*, "[t]he PTO has made it clear that registration does not constitute approval of a mark. . . . And it is unlikely that more than a tiny fraction of the public has any idea what federal registration of a trademark means." 137 S. Ct. at 1759. Moreover, "there is no evidence that the pubic associates the contents of trademarks with the Federal Government." *Id.* at 1760. Thus, Petitioner is simply incorrect in claiming that "[t]he government's association with a registered mark is an unavoidable facet of the trademark-registration program." Pet. Br. 35. Rejecting registration of scandalous marks does nothing to avoid any appearance of government approval of such marks.

While failing to advance any compelling or substantial government interest, the scandalous-marks provision impermissibly chills expression. Entrepreneurs and advocates considering a slogan or name will wonder whether they can register it. They may think twice about whether the PTO will find it "offensive," but will have little ability to predict the vagaries of an examiner. "Many persons, rather than undertake the considerable burden (and sometimes risk) of vindicating their rights through case-by-case-litigation, will choose simply to abstain

from protected speech—harming not only themselves but society as a whole, which is deprived of an uninhibited marketplace of ideas." *Virginia v. Hicks*, 539 U.S. 113, 119 (2003). Consumers will suffer if they are deprived of a robust marketplace of goods, services, and ideas, as they will be under the government's approach, which requires providers of goods and services to play it safe, or to think twice before choosing a controversial logo or slogan because they may not have the endurance to fight the PTO. The Court should not allow the PTO—or members of the public whom the PTO attempts to protect from offense—to exercise a discretionary veto over speech it dislikes.

CONCLUSION

The decision of the Federal Circuit should be affirmed.

Respectfully submitted,

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